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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92056035
Party	Defendant Limited liability company; "Autoplastic"
Correspondence Address	SERGEI OREL MISKIN & TSUI-YIP LLP 1350 BROAWAY, SUITE 820 NEW YORK, NY 10018 UNITED STATES sorel@sergei-orel.com
Submission	Answer
Filer's Name	Sergei Orel
Filer's e-mail	sergei@mt-iplaw.com
Signature	/Sergei Orel/
Date	12/15/2012
Attachments	STP - Amended Answer to Cancellation Notice 12-14-12.pdf ( 11 pages ) (118807 bytes )

**THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration Number No. 4,137,345  
Mark: StP & Design in Class 17

-----X  
THE ARMORALL/STP PRODUCTS  
COMPANY, :  
  
Petitioner, : **AMENDED ANSWER TO**  
 : **PETITION FOR**  
vs. : **CANCELLATION AND**  
 : **AFFIRMATIVE DEFENSES**  
LIMITED LIABILITY COMPANY; :  
AUTOPLASTIC :  
 : **Cancellation No. 92056035**  
Registrant.  
-----X

TO THE TRADEMARK TRIAL AND APPEAL BOARD:

Registrant, Limited Liability Company; Autoplastic, (hereinafter “Autoplastic” or the “Registrant”), through the undersigned attorney, hereby answers the Petition for Cancellation (hereinafter the “Cancellation”) by way of an AMENDED ANSWER, which replaces the ANSWER that was originally filed on November 24, 2012 with the TTAB, which appears to have been defectively uploaded to ESTTA by having pages 2 through 9 appear blank as a result of an upload. Furthermore, Petitioner requested that

**CERTIFICATE OF SERVICE**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Trademark Trial and Appeal Board, U.S. Patent and Trademark Office, P.O. Box 1451, Alexandria, VA 22313-1451, on the date shown below:

Sergei Orel  
(Name of Person Signing Certificate)  
/Sergei Orel/  
(Signature)  
December 14, 2012  
(Date)

more complete answers to allegations contained in paragraphs 14-15, 32, and 34-35, be filed, and it was agreed between the parties that such more complete answers would be filed. Registrant hereby answers the Petition for Cancellation as follows:

1. As to paragraph 1 of the Cancellation, Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in said paragraph, and on that basis denies each and every allegation contained therein.

2. As to paragraph 2 of the Cancellation, Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in said paragraph, and on that basis denies each and every allegation contained therein.

3. As to paragraph 3 of the Cancellation, Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in said paragraph, and on that basis denies each and every allegation contained therein.

4. As to paragraph 4 of the Cancellation, Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in said paragraph, and on that basis denies each and every allegation contained therein.

5. As to paragraph 5 of the Cancellation, Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in said paragraph, and on that basis denies each and every allegation contained therein.

6. As to paragraph 6 of the Cancellation, Registrant states that the registration records of the USPTO speak for themselves. The remaining allegations

constitute conclusions of law or other non-factual allegations to which no answer is required. If any of the allegations in this paragraph are considered factual, Registrant is without knowledge or information sufficient to form a belief as to the truth of such factual allegations contained in said paragraph, and on that basis denies each and every allegation contained therein.

7. As to paragraph 7 of the Cancellation, Registrant states that the registration records of the USPTO speak for themselves. The remaining allegations constitute conclusions of law or other non-factual allegations to which no answer is required. If any of the allegations in this paragraph are considered factual, Registrant is without knowledge or information sufficient to form a belief as to the truth of such factual allegations contained in said paragraph, and on that basis denies each and every allegation contained therein.

8. As to paragraph 8 of the Cancellation, Registrant admits the allegations contained in said paragraph.

9. As to paragraph 9 of the Cancellation, Registrant admits the allegations contained in said paragraph.

10. As to paragraph 10 of the Cancellation, Registrant denies each and every allegation contained therein.

11. As to paragraph 11 of the Cancellation, Registrant denies each and every allegation contained therein.

12. As to paragraph 12 of the Cancellation, Registrant states that the registration records of the USPTO speak for themselves. Registrant denies each and every remaining allegation contained therein.

13. As to paragraph 13 of the Cancellation, Registrant states that the registration records of the USPTO speak for themselves. Registrant denies each and every remaining allegation contained therein.

14. [AMENDED] The allegations in paragraph 14 of the Cancellation in respect of Registrant not using its StP mark (the “Mark”) appearing in colors blue and white are denied. It is admitted that in addition to using the Mark in colors blue and white, Registrant also uses the mark in colors other than blue and white. It is admitted that STP Atlantic LLC is a company related to Registrant.

15. [AMENDED] It is admitted that an image of a generic looking race car shaped car appears on Registrant’s website on the Internet. It is admitted that the StP Mark appeared on television.

16. Registrant reiterates and incorporates by reference the above answers to allegations contained in paragraphs 1 through 15 as if fully set forth herein.

17. As to paragraph 17 of the Cancellation, Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in said paragraph, and on that basis denies each and every allegation contained therein.

18. As to paragraph 18 of the Cancellation, Registrant denies each and every allegation contained therein.

19. As to paragraph 19 of the Cancellation, Registrant denies each and every allegation contained therein.

20. As to paragraph 20 of the Cancellation, Registrant states that the allegations contained therein are conclusions of law to which no answer is required, and on that basis Registrant denies each and every allegation contained therein. With respect

to any factual allegations contained in said paragraph, Registrant denies each and every allegation contained therein.

21. As to paragraph 21 of the Cancellation, Registrant denies each and every allegation contained therein.

22. Registrant reiterates and incorporates by reference the above answers to allegations contained in paragraphs 1 through 21 as if fully set forth herein.

23. As to paragraph 23 of the Cancellation, Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in said paragraph, and on that basis denies each and every allegation contained therein.

24. As to paragraph 24 of the Cancellation, Registrant states that the allegations contained therein are conclusions of law to which no answer is required, and on that basis Registrant denies each and every allegation contained therein. With respect to any factual allegations contained in said paragraph, Registrant denies each and every allegation contained therein.

25. As to paragraph 25 of the Cancellation, Registrant states that the allegations contained therein are conclusions of law to which no answer is required, and on that basis Registrant denies each and every allegation contained therein. With respect to any factual allegations contained in said paragraph, Registrant denies each and every allegation contained therein.

26. As to paragraph 26 of the Cancellation, Registrant denies each and every allegation contained therein.

27. Registrant reiterates and incorporates by reference the above answers to allegations contained in paragraphs 1 through 26 as if fully set forth herein.

28. As to paragraph 28 of the Cancellation, Registrant admits the allegations contained in said paragraph, and further states that the USPTO registration records speak for themselves.

29. As to paragraph 29 of the Cancellation, Registrant admits the allegations contained in said paragraph, and states that the USPTO registration records speak for themselves.

30. As to paragraph 30 of the Cancellation, Registrant admits the allegations contained in said paragraph, and further states that the USPTO registration records speak for themselves.

31. As to paragraph 31 of the Cancellation, Registrant admits the allegations contained in said paragraph, and further states that the USPTO registration records speak for themselves.

32. [AMENDED] All the allegations in paragraph 32 are denied in their entirety.

33. As to paragraph 33 of the Cancellation, Registrant admits the allegations contained in said paragraph, and further states that the USPTO registration records speak for themselves.

34. [AMENDED] All the allegations in paragraph 34 are denied in their entirety.

35. [AMENDED] Denied.

36. Denied.

#### AFFIRMATIVE DEFENSES

1. Petitioner has failed to allege grounds sufficient to sustain the Cancellation.

2. Petitioner's claims are barred by the equitable doctrines of acquiescence, laches and/or estoppel.

3. The Registrant is entitled to maintain the Registration of the subject StP trademark (hereinafter, the "StP" mark), since Registrant's mark is distinctive from Petitioner's "STP" trademarks according to the tests of visual, phonetic, and commercial impression comparison.

4. The Registrant is entitled to maintain the Registration of StP trademark in International Class 17, since the goods in Registrant's registration are different from those of Petitioner, and moreover, the subject StP trademark is registered in Class 17, i.e., a Class that is different from all of the classes in Petitioner's registrations.

5. The Registrant's StP trademark was registered in International Class 17 in respect of the following goods:

"insulating paper for acoustical, acoustic, thermal and heat insulation of automobiles; insulating felt for automobiles; insulators for automobiles, namely, polyurethane and penopolyethylene insulators of interiors of automobile and other automobile parts from noise, heat and corrosion; insulating tape and band, adhesive bands being tapes all being other than stationery and not for medical or household purposes; soundproofing materials for automobiles; insulating materials; insulating refractory materials; rubber material for recapping tires or tyres; non-conducting materials for retaining heat, namely, insulating penopolietilen being polyethylene foam, polyurethane foam, and foam plastic



membranes for insulating surfaces of automobiles; sealant compounds for joints; insulating plaster; cords of rubber for cylinder jointings, pipe gaskets and joint packings for pipes; non-metal gaskets for joint packings and seals in the automotive industry; substances for insulating buildings against moisture, namely, polyurethane film for use as a moisture barrier; fiberglass insulation for automobiles; insulating fabrics; waterproof packings for water-tight rings; foils of metal for insulating automobiles”.

6. Even though Petitioner had failed to list the classes in which its registrations were registered in its table in Paragraph 6 of its Cancellation Petition, it is undisputed that Petitioner’s STP registrations that it listed in its Petition for Cancellation cover different goods in classes that are different from the Registrant’s goods in International Class 17 in the Registrant’s current StP registration. Petitioner has no “STP” mark registrations registered in International Class 17. Petitioner’s main business activities are related to sales of motor oils, brake fluids, cleaners, lubricants, tire shine preparations, filters, etc., i.e., goods that are different than the above listed insulating materials of the Registrant.

7. The Registrant is entitled to maintain the subject registration for the subject mark StP in International Class 17 in respect of “insulating paper for acoustical, acoustic, thermal and heat insulation of automobiles; insulating felt for automobiles; insulators for automobiles, namely, polyurethane and penopolyethylene insulators of interiors of automobile and other automobile parts from noise, heat and corrosion; insulating tape and band, adhesive bands being tapes all being other than stationery and not for medical or household purposes; soundproofing materials for automobiles;

insulating materials; insulating refractory materials; rubber material for recapping tires or tyres; non-conducting materials for retaining heat, namely, insulating penopolietilen being polyethylene foam, polyurethane foam, and foam plastic membranes for insulating surfaces of automobiles; sealant compounds for joints; insulating plaster; cords of rubber for cylinder jointings, pipe gaskets and joint packings for pipes; non-metal gaskets for joint packings and seals in the automotive industry; substances for insulating buildings against moisture, namely, polyurethane film for use as a moisture barrier; fiberglass insulation for automobiles; insulating fabrics; waterproof packings for water-tight rings; foils of metal for insulating automobiles”, because the Registrant properly filed an application for said mark which was examined by the USPTO and issued a Certificate of Registration.

8. The use and registration of Registrant’s mark is not likely to cause confusion, to cause mistake, or to deceive the public as to source or origin of Registrant’s goods.

9. There is no likelihood of confusion or mistake because, *inter alia*, Registrant’s mark and Petitioner’s alleged marks are not confusingly similar.

10. There is no likelihood of confusion or mistake because, *inter alia*, Registrant’s mark and Petitioner’s alleged mark convey different commercial impressions.

11. There is no likelihood of confusion or mistake because, *inter alia*, Registrant’s mark and Petitioner’s alleged mark are dissimilar as to appearance.

12. There is no likelihood of confusion or mistake because, *inter alia*, consumers are not likely to believe that the goods bearing the Registrant's mark originate with or are authorized by Petitioner.

13. Upon information and belief, goods offered for sale by Petitioner, and goods covered by Registrant's trademark, are offered to dissimilar consumer groups, and circulate in different channels of commerce.

WHEREFORE, Registrant prays that the Petition for Cancellation be dismissed in its entirety, with prejudice.

Respectfully submitted.

Dated: 14 December 2012

Miskin & Tsui-Yip, LLP

By: /Sergei Orel/  
Sergei Orel  
Miskin & Tsui-Yip, LLP  
Attorneys for Registrant  
1350 Broadway, Suite 802  
New York, NY 10018  
Phone: (212) 268-0900  
Fax: (212) 268-0904  
Email: sergei@mt-iplaw.com

### **CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing ANSWER TO PETITION FOR CANCELLATION AND AFFIRMATIVE DEFENSES was mailed by first-class mail, postage prepaid, in an envelope addressed to Jason Jones, Esq., and Crais S. Mende, Esq., Fross Zelnick Lehrman & Zissu, P.C., 866 United Nations Plaza at First Avenue & 48<sup>th</sup> Street, New York, New York, 10017, attorneys for Petitioner, this 14<sup>th</sup> day of December 2012.

/Sergei Orel/  
Sergei Orel